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**REMARKS**

In the Office Action, the Examiner noted that claims 1-51 are pending in the application, and that claims 1-51 are rejected. By this Amendment, no claims have been amended, and claims 52-53 have been added. Thus, claims 1-53 are pending in the application.

The Examiner's rejections are traversed below.

**Prior Art Rejections**

Claims 1-51 are rejected under 35 U.S.C. Section 103 as being obvious in view of Mahar U.S. Patent 6,769,228, Absher U.S. Patent 5,298,104, Braheir U.S. Patent 6,688,346 and Kramer U.S. Patent 5,570,568. Applicant respectfully disagrees.

Applicant provides the following remarks. First, the Mahar patent was filed on July 26, 2002, which is only 2 weeks before the priority date of the present application, i.e., August 7, 2002. Applicant is submitting herewith a partial copy of the technical documentation associated with the present invention illustrating the overall invention design having a date of April 23, 2001. Applicant is also submitting herewith a declaration under 37 CFR 1.131 by the inventors confirming that the invention was conceived at least by April 23, 2001, and diligently reduced to practice at least prior to July 26, 2002. Therefore, withdrawal of this rejection on this basis alone is respectfully requested.

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In addition, the Mahar patent does not directly relate to the bagger system of the present invention, but is generally related to an overall automated packing system having a packing controller that calculates package weight based on container weight. Thus, Mahar does not describe the combination of elements in the bagger system in the present invention.

For example, the Mahar patent does not disclose or suggest the claimed elements of "a first plurality of rollers contacting the bag film... and being driven to convey the bag film." In addition, the Mahar patent does not disclose or suggest "a second plurality of rollers... to convey the plurality of labels and backing materials for indicia to be printed thereon." In addition, the Mahar patent does not appear to show or suggest "a label removal and tamp mechanism... that selectively removes the printed label containing information corresponding to the particular order from the backing material." The Mahar patent also does not appear to show or suggest the feature of "a third sensor for detecting a position of a perforation between the bag and a second bag." Further, the Mahar patent does not show or suggest that the "first plurality of rollers rotates in a second direction subsequent to sealing the bag to break a perforation between the bag and a second bag." Accordingly, Applicant respectfully submits that the Mahar patent does not show many of the features of the present invention.

The Examiner states that in connection with claims 4, 12-15, 22, 30-34 and 44 it is inherent to provide these features. Applicant disagrees. Specifically, inherency and obviousness are separate and unrelated concepts. As stated by the Court of Customs and Patent Appeals:

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[The] inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

*In re Spormann*, 363 F.2d 444, 150 USPQ 449, 452 (C.C.P.A. 1966). See also *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999) ("Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.").

Further, the Patent Office Board of Patent Appeals and Interferences has similarly stated:

[T]he examiner talks in terms of inherency (which is really an anticipation rationale) while on the other hand the examiner talks in terms that it would have been obvious to experiment to divine optimum conditions. Inherency and obviousness are somewhat like oil and water – they do not mix well. Claimed subject matter can be anticipated because a prior art reference describes a method which inherently meets the limitations of a claimed method. Claimed subject matter can be unpatentable for obviousness when, notwithstanding a difference between that subject matter and a prior art reference, the claimed subject matter, as a whole, would have been obvious. However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory.

*Ex parte Schricker*, 56 USPQ2d 1723, 1725 (B.P.A.I. 2000) (unpublished).

Accordingly, Applicant requests the Examiner to provide a prior art references or affidavit under 37 CFR 1.104(d)(2) to support this rejection. In the absence of either, Applicant respectfully requests the Examiner to withdraw the rejection.

Applicant further respectfully submits that the secondary prior art references are also unrelated to the present invention.

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For example, Absher describes a unique type of shopper's coupon and method of applying it to grocery shopping bags. In Absher, the coupon is adhered to a backing paper that is in turn applied to a grocery bag (either plastic or paper) in the bag making process. The coupons are preprinted (on both sides), and are all the same for a given run. The adhesive stays with the backing paper so that there is no residue on the coupon when it is removed from the bag. In contrast, in the present invention, the labels are not preprinted, patient specific, and they are not meant to be removed from the bag. Further, Absher relates to grocery bags, and the bagging machine of the present invention is not related at all to grocery bags but is related to a shipping bag and/or container where a patient specific order is inserted therein.

In addition, the Absher patent refers to a "blow on" method of label application (typical of a Labelaire machine). In contrast, in at least one embodiment of the present invention, the present invention utilizes a transfer pad that physically presses the pressure sensitive label onto the bag before it is loaded. In addition, in at least one embodiment, a sensor detects a perforation between preformed bags, using that information to stop the bag and open it for loading. Further, the present invention is, in at least one embodiment, utilized with, in combination and/or part of an overall order consolidation and bag packing system, whereas the Absher patent describes a stand alone machine for fabricating bags with removable coupons affixed to each bag. Since the bags in Absher are "shopping bags", there is no mention of how the bags are loaded or sealed.

The Mahar patent relates to an overall packing system used for weighing contents in a shipping container, and just happens to include a bagger. However, very little in Mahar is

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mentioned regarding the actual bagging machine. The Mahar method uses vacuum plates placed above and below the horizontal bag. The vacuum holds the bottom side of the bag down while the upper vacuum plate lifts the entire top side of the bag upward. In at least one embodiment of the present invention, one side of the vertical bag is still attached to the web, while the top edge of the other side is engaged by a gripper mechanism that grabs hold of the lip of the bag and moves it outward to open the mouth of the bag.

In addition, the Mahar patent uses a horizontal bagger where a mechanical device grips the contents, physically moves it into the open bag, then releases the contents inside the bag, and finally retracts the loading device out of the bag. In the present invention, however, in at least one embodiment, a release mechanism moves the contents toward the mouth of the bag, and the force of gravity causes the contents to travel into the bag by, e.g., dropping the contents into the bag below, from a location above the bag. Thus, the Mahar method is inherently slower than the present invention because the bag loading mechanism must travel into the bag to make sure that contents actually get into the bag.

The Brahier patent describes a machine for bag feeding and loading for printing information on the bag by integrating a commercially available printing machine. Accordingly, the Brahier patent is unrelated to the present invention that prints patient specific information on a label that is applied to a container or bag. In addition, as described below, the Brahier patent cannot be used in the present invention, and therefore, Applicant respectfully submits that any rejection relying on the Brahier patent must be withdrawn.

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For example, in the Brahier patent, a jet of air is used to get the bag to move downward. In contrast, in the present invention, in at least one embodiment, the upper roller is used to aim the bag downward (rather than out) when the bag is deployed. This downward motion is one important factor in being able to speed up the machine cycle time.

In addition, in the Brahier patent, a notched nip roller and interweaving spring fingers are used to keep the bag material from wrapping around the nip roller rather than deploying downward for opening and loading. In the present invention, however, label application (as opposed to printing on the bag) allows for controlled tension on the bag web while deploying the bag for opening and loading. Accordingly, the present invention has no need for the complex and cumbersome notched nip roller and interweaving spring fingers in the Brahier patent.

Therefore, the Brahier system and method is inherently slower than the present invention because the "printing on the bag" operation takes longer than the label application operation. Estimates are that the Brahier bagger would load 7 to 9 bags each minute, as compared to the present invention where speeds are in excess of 15 bags per minute. In addition, the Brahier patent describes merely a stand alone machine for forming bags and printing unique label information on each bag. There is no mention of how this bagger is integrated into an overall order consolidation and packaging system, as in the present invention.

The Kramer patent describes a method for sealing a bag while simultaneously reversing the nip rollers to separate the loaded bag from the web. While acceptable for a

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slower speed bagger, Kramer is still problematic, resulting in some bags having poor seals (the seal gets deformed by the tension that is applied to separate the loaded bag from the web). In at least one embodiment, the present invention separates the loaded bag from the web first, then seals the bag (all bags have good quality seals). In addition, while Kramer allows for both "automatic" as well as "semi-automatic" operation, the safety features in the Kramer design are consistent with a semi-automatic machine (an operator must load the bag and actuate the sealing sequence).

In addition, the Kramer patent makes reference to a "bagging machine system" with multiple baggers controlled by a central computer. In contrast, the present invention has improved upon this concept by designing the bagger with an onboard controller that has the capability to run all functions of the bagger when it is in an off line set up mode. When the bagger is plugged into the overall order consolidation and packing station, the station controller takes over and coordinates the bagger function with the order consolidation and loading function.

Further, the Kramer patent describes a stand alone machine for loading and sealing bags. There is no mention of how this bagger is integrated into an overall order consolidation and packaging system.

Without conceding that the prior art shows any of the elements of, for example, claim 1, the prior art does not disclose, for example, the combination of limitations recited in claim 1, including "a first plurality of rollers contacting a bag film comprising a plurality of bags, each of the bags delimited by a perforation, said first plurality of rollers defining an area

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through which the bag film is conveyed, and rotating in concert in a first direction to convey the bag film, at least one of said plurality of rollers being driven to convey the bag film; a printer for printing a plurality of labels, each label containing information corresponding to a particular order, disposed on a backing material; and a second plurality of rollers contacting the plurality of labels and the backing material, said second plurality of rollers defining an area through which the plurality of labels and the backing material are conveyed, and rotating in concert to convey the plurality of labels and the backing material for indicia to be printed thereon." In addition, claim 1 recites, in combination, "a label removal and tamp mechanism that receives at least one printed label containing information corresponding to the particular order, selectively removes the printed label containing information corresponding to the particular order from the backing material, and places the printed label on the bag."

Even combining the teachings of the prior art, the combination of elements of claim 1, when interpreted as a whole, is not disclosed. As the combination of elements of claim 1 are not disclosed when claim 1 is interpreted as a whole, Applicants respectfully request that the Examiner withdraw the rejection with respect to claim 1 and its dependent claims 2-19, which incorporate all of the features of claim 1. Moreover, dependent claims 2-19 are independently patentable based on the combination of elements recited therein.

For example, dependent claim 15 recites, in combination, "a switch that is engaged by said cam, wherein one of said second plurality of rollers comprises a label roll, and wherein when said switch is engaged by said cam, labels are dispensed from said label roll." Accordingly, for these reasons, and for the reasons described above, Applicant respectfully



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submits that claims 2-19 patentably distinguish over the prior art. Withdrawal of this rejection is respectfully requested.

**Remaining Claims 20-51 and New Claims 52-53**

Applicant respectfully submits that the combination of limitations in each of the independent and dependent claims 20-53 patentably distinguishes over the prior art. Withdrawal of this rejection is respectfully requested.

In addition, each of the combination of limitations recited in claims 20-53, includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicant respectfully requests withdrawal of the rejection.

For example, dependent claim 30 recites "said second dancer assembly comprising a roller under a biasing force, said roller moving dynamically as labels are received by said printer."

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art, the combination of elements of claims 1-53, when each is interpreted as a whole, is not disclosed. As the combination of elements in the claims is not disclosed, Applicant respectfully requests that the Examiner withdraw the rejections. Accordingly, for these reasons, and for the reasons described above, Applicant respectfully submits that claims 20-53 patentably distinguish over the prior art. Withdrawal of this rejection is respectfully requested.

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In view of the above arguments, Applicant respectfully contends that the art of record, taken alone or in combination, does not disclose all of the features of the present invention as claimed in claims 1-53. As such, Applicant respectfully requests allowance of claims 1-53.

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### **CONCLUSION**

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior

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art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

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For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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